

REMARKS

This application has been carefully reviewed in light of the Office Action dated December 31, 2007. Claims 1 to 39, 44, 45 and 53 to 58 are in the application, of which Claims 1 and 53 to 58 are independent. Reconsideration and further examination are respectfully requested.

A formal objection was lodged against Claim 1, which has been attended to by amendment above.

Claims 55 and 56 were rejected under 35 U.S.C. § 101, as allegedly being directed to non-statutory subject matter. The rejection is again traversed, for the reasons of record, which are incorporated herein by reference. It is again respectfully noted that the Office Action itself concedes that the claims are “directed towards a physical apparatus”, such that it cannot be understood why the Office Action persists in its view that the claims somehow do not fall into “any of the four enumerated categories of patentable statutory subject matter”.

It appears that the Office Action is taking the position that since embodiments of the invention are implemented through software, that the claims cannot be statutory *per se*. This precise point was addressed by the Federal Circuit in its *en banc* decision in *In re Alappat*. There, the USPTO had rejected a claim under § 101 for non-statutory subject matter, and took the position that a programmed general purpose computer could not be viewed as patentable under § 101. The Federal Circuit reversed,

and clearly articulated a reasoning that applies to the rejected claims herein, as to why such claims recite statutory subject matter:

“The reconsideration Board majority also erred in its reasoning that claim 15 is unpatentable merely because it ‘reads on a general purpose digital computer ‘means’ to perform the various steps under program control.’ *Alappat*, 23 USPQ2d at 1345. The Board majority stated that it would ‘not presume that a stored program digital computer is not within the Section 112 Para. 6 range of equivalents of the structure disclosed in the specification.’ *Alappat*, 23 USPQ2d at 1345. *Alappat* admits that claim 15 would read on a general purpose computer programmed to carry out the claimed invention, but argues that this alone also does not justify holding claim 15 unpatentable as directed to nonstatutory subject matter. We agree. **We have held that such programming creates a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software.** *In re Freeman*, [573 F.2d 1237] 573 F.2d 1237, 1247 n.11, 197 USPQ 464, 472 n.11 (CCPA 1978); *In re Noll*, [545 F.2d 141] 545 F.2d 141, 148, 191 USPQ 721, 726 (CCPA 1976); *In re Prater*, [415 F.2d 1403] 415 F.2d at 1403 n.29, 162 USPQ at 549-50 n.29.

“Under the Board majority's reasoning, a programmed general purpose computer could never be viewed as patentable subject matter under Section 101. This reasoning is without basis in the law. The Supreme Court has never held that a programmed computer may never be entitled to patent protection. Indeed, the *Benson* court specifically stated that its decision therein did not preclude ‘a patent for any program servicing a computer.’ *Benson*, [409 US 71] 409 U.S. at 71. Consequently, a computer operating pursuant to software may represent patentable subject matter, provided, of course, that the claimed subject matter meets all of the other requirements of Title 35. In any case, a computer, like a rasterizer, is apparatus not mathematics.” *In re Alappat*, 31 USPQ2D 1545 at 1558 (Fed. Cir. 1994)(en banc)(emphasis in added).

Much like the flawed reasoning of the Board in *Alappat*, the instant rejection would also preclude patentability of programmed general purpose, and thus is similarly flawed. Withdrawal of the § 101 rejection is respectfully requested.

Independent Claims 1, 53, 55 and 57, together with many of the dependent claims, were rejected under 35 U.S.C. § 103(a) over U.S. Patent 6,125,390 (Touboul) in view of U.S. Patent 6,546,484 (Hirai) and further in view of U.S. Patent Application Publication 2003/0037098 (Niwa '098). Other claims depending from independent Claim 1 were rejected further in view of U.S. Patent 5,696,701 (Burgess) or U.S. Patent 6,167,567 (Chiles). In addition, independent Claims 54, 56 and 58 were rejected under 35 U.S.C. § 103(a) over Niwa '098 in view of U.S. Patent Application Publication 2001/0025312 (Obata) and further in view of Hirai.

Thus, all art-based rejections in this case rely on the citation to Niwa '098. The rejection is thus respectfully traversed, since Niwa '098 is not prior art to the subject application, for the purposes of a rejection entered under § 103(a), by virtue of the language of § 103(c)..

The status of Niwa '098 has been raised before on two separate occurrences^{1/}, where it was explained that the USPTO's reliance on Niwa '098 is improper under 35 U.S.C. § 103(c), since Niwa '098 and the subject application are commonly owned by Canon Kabushiki Kaisha. These two prior explanations were apparently unheeded, perhaps because the explanations were not considered sufficiently "conspicuous", and therefore the following conspicuous statement is made:

The instant application and Niwa '098 were, at the time the invention of the instant application was made, owned by Canon Kabushiki Kaisha.

^{1/}See Amendment dated October 9, 2007 at page 21 and Amendment dated February 16, 2007 at page 18.

Withdrawal of all rejections is therefore respectfully requested.

The USPTO has also been advised previously that there is a published foreign counterpart to Niwa '098, at Japan 7-93230, published April 7, 1995 (Niwa '230). If the USPTO decides to reinstate its rejection, substituting Niwa '230 for Niwa '098, then the following clarifications of the rejection are respectfully requested.

First, clarification is requested of the status of Claim 14. Claim 14 was not listed among the rejected claims at page 16 of the Office Action, but a reference to Claim 14 is made at page 24 of the Office Action. The status of Claim 14 cannot be determined.

Second, clarification is requested of the status of Claims 37 through 39. Claims 38 and 39 depend from Claim 37, but the rejection of Claims 38 and 39 (at page 16 of the Office Action) is inconsistent with the rejection of Claim 37 (at page 25 of the Office Action). The status of Claims 37 to 39 cannot be determined.

Third, although page 25 of the Office Action rejects Claims 41 to 43, these claims have been cancelled. Clarification is requested.

Applicant further wishes to make of record other traversals of the technological and legal predicates used by the Office Action in entering its art-based rejections. The Office Action continues to take the position that there is no technological difference, in principle, between a local bus system within a computer (such as that disclosed in Hirai) and a network system including plural multifunction network devices. Applicant continues to believe that such a position is technologically naive, since there are significant differences between a local bus system and network-based architecture, such that art from the two cannot be combined easily, and certainly would not have been

apparent to those of ordinary skill. For example, a local bus system has a main CPU which controls signals between a RAM and a ROM. In a network system, on the other hand, multifunction network devices are connected by a network and thus are quite different from a simple RAM and ROM connected to a CPU by a local bus. Moreover, in a local bus system, the CPU controls everything, whereas there is no single controller that controls everything on a network. In addition, a RAM and ROM in a local bus system can use the same address mapping information, but such a simplification is not available on a network system.

The continued use of Applicant's own disclosure, in providing a rationale for an art-based rejection, is again noted with disapproval. The Office Action relies on Applicant's own disclosure, at pages 1 and 35, to somehow "prove" that it would have been obvious to combine the applied references. For example, page 11 of the Office Action specifies the following:

"Applicant's disclosure, by itself, is evident to show the obviousness, i.e. to show that why one of ordinary skilled in the art would have been prompted to modify Touboul and NIWA in manner that would have resulted in the present invention, for example: see specification pg. 35, wherein applicant discloses that the invention can be used to manage various other types of network devices."

Thus, although other pages of the Office Action state that the USPTO has not relied on Applicant's own disclosure, it is clear from the above quotation that it indeed has. It is simply not permissible to rely on Applicant's own disclosure in proving obviousness, and no contortion of the Supreme Court's holding in *KSR* would somehow make this legitimate.

As an aside, Applicant's disclosure at page 35 is correct: the invention indeed can be applied to manage other types of network devices. However, such management of an unspecified device is not now claimed. In other words, Applicant is not now seeking a patent for management of any network device; rather, Applicant is now seeking a patent for management of the claimed multifunction network devices. It is improper to reject claims over subject matter not embraced by them.

In explaining its position that the claims are not somehow directed to multifunction network devices, the Office Action inferred that since these recitations occur in the preamble, they are merely statements of intended use and were not afforded any patentable weight. Whether a preamble is or is not a limitation to a claim is determined based on all facts, including the following: (a) reliance on a preamble phrase for antecedence in the body of the claim; (b) whether the preamble is needed to understand other terms in the body of the claim; (c) whether the preamble recites additional structure or steps underscored as important in the specification; and (d) reliance on the preamble during prosecution. These factors were explained by the Federal Circuit in its *Catalina Marketing* decision:

“No litmus test defines when a preamble limits claim scope. Corning Glass, 868 F.2d at 1257. Some guideposts, however, have emerged from various cases discussing the preamble's effect on claim scope. For example, this court has held that Jepson claiming generally indicates intent to use the preamble to define the claimed invention, thereby limiting claim scope. Rowe, 112 F.3d at 479; Epcon Gas Sys., Inc. v. Bauer Compressors, Inc., 279 F.3d 1022, 1029, 61 USPQ2d 1470, 1475 (Fed. Cir. 2002). Additionally, dependence on a particular disputed preamble phrase for antecedent basis may limit claim scope because it indicates a reliance on both the preamble and claim body to define the claimed invention. Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d

615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995) ('[W]hen the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects.'). Likewise, when the preamble is essential to understand limitations or terms in the claim body, the preamble limits claim scope. *Pitney Bowes*, 182 F.3d at 1306.

"Further, when reciting additional structure or steps underscored as important by the specification, the preamble may operate as a claim limitation. *Corning Glass*, 868 F.2d at 1257 (limiting claim scope to 'optical waveguides' rather than all optical fibers in light of specification); *General Electric Co. v. Nintendo Co.*, 179 F.3d 1350, 1361-62, 50 USPQ2d 1910, 1918-19 (Fed. Cir. 1999) (limiting claim scope to a 'raster scanned display device' rather than all display systems in view of specification's focus on the prior art problem of displaying binary data on a raster scan display device); *Rowe*, 112 F.3d at 479-80; *Applied Materials*, 98 F.3d at 1573.

"Moreover, clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention. See generally *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1375, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (A preamble may limit when employed to distinguish a new use of a prior art apparatus or process.). Without such reliance, however, a preamble generally is not limiting when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention. *IMS Tech., Inc. v. Haas Automation, Inc.*, 206 F.3d 1422, 1434, 54 USPQ2d 1129, 1136-37 (Fed. Cir. 2000) (preamble phrase 'control apparatus' does not limit claim scope where it merely gives a name to the structurally complete invention). Thus, preamble language merely extolling benefits or features of the claimed invention does not limit the claim scope without clear reliance on those benefits or features as patentably significant. *STX, LLC v. Brine, Inc.*, 211 F.3d 588, 591 (Fed. Cir. 2000) (preamble stating that invention provides 'improved playing and handling characteristics' is not a limitation); *Bristol-Myers*, 246 F.3d at 1375 (steps of claimed method are performed the same way regardless of whether, as stated in the preamble, a reduction of hematologic toxicity occurs)." *Catalina Marketing International Inc. v. Coolsavings.com Inc.*, 62 USPQ2D 1781 at 1785 (Fed. Cir. 2002)

It is respectfully submitted that the nature of the multifunction devices described in the preambles of the claims herein should be afforded patentable weight.

Overall, it is respectfully submitted that nothing in the applied art would have suggested the general concepts claimed herein, of executing function modules in networked multifunction devices, deleting the function modules and retrieving deleted function modules over the network so as to reconfigure the multifunction devices, all in response to an increase or decrease in demand for hardware resources of the multifunction device.

Applicant's undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael K. O'Neill", is written over a horizontal line.

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